

REMARKS

In response to the Communication mailed May 5, 2003, asserting that the reply filed March 24, 2003 to the Official Action mailed February 26, 2003 is improper and/or incomplete, Applicant requests reconsideration.

Specifically, Applicant requests the Examiner take one of two alternative actions. First, Applicant requests the withdrawal of the Official Action of February 26, 2003 and the Communication of May 5, 2003, followed by issuance of a new replacement Official Action either examining all of the claims on the merits or issuing a restriction requirement consistent with the instructions of MPEP.

Second, if the Examiner declines to take the first requested action, then Applicant requests that the Examiner make final the species election requirement of February 26, 2003 so that a petition can be filed seeking supervisory review. This reply constitutes a second request for reconsideration of the restriction requirement of February 26, 2003.

The restriction requirement of February 26 2003 is internally inconsistent and contrary to established practice as well as the instruction of the MPEP. At the first paragraph of the requirement, the Examiner asserts, erroneously in the view of the Applicant, that there are 12 species of "heatsink designs" depicted in the figures of the patent application. Applicant traverses this assertion. If the Examiner intends to be consistent with respect to these alleged species, then there are 14 species. The Examiner has apparently overlooked Figures 12 and 13.

The second paragraph at page 2 of the Official Action mailed February 26, 2003 states that the Applicant is required to "elect a single disclosed species of heat sink, a single species of fan mounting arrangement, a single species of attachment clip arrangement, and a single disclosed species of assembly means...". This requirement indicates, at best, a confused understanding of what constitutes a species. The MPEP clearly explains that embodiments of an invention described in a patent application may be species. There is no authorization in any section of the MPEP for the Examiner to dismember embodiments and to decide, particularly independent of claimed subject matter, what constitutes a species.

In two telephone conversations with the undersigned on May 8, 2003, the Examiner explained that the requirement of the second paragraph of page 2 of the Official Action of February 26, 2003 requires that the Applicant identify an elected figure for *each* of the four supposed species identified. This requirement is illegal and unauthorized because it is contrary to what the MPEP and established practice is with respect to identification of species. In more than 20 years of experience, the undersigned has never received a species election requirement like the second paragraph at page 2 of the Official Action of February

26, 2003. Because that demand is illegal and unauthorized, the response filed March 24, 2003 was completely responsive to the legitimate part of the Official Action of February 26, 2003. Therefore, the Communication mailed May 5, 2003 was incorrect and also unauthorized. The Communication merely propagates the error in the Official Action of February 26, 2003. Because of that error, Applicant requests the withdrawal of the Communication and supplying of a document upon which Applicant can request a refund of the extension of time fee that had to be paid in order to respond to the illegitimate Communication of May 5, 2003.

An attempt to conform to the demanded election in paragraph 2 of the Official Action of February 26, 2003 demonstrates why such requirements are not authorized and cannot be permitted. According to the telephone conversations of May 8, 2003, the Examiner expects that an example of a heat sink, an example of a fan mounting arrangement, an example of an attachment clip arrangement, and an example of an assembly means will be separately and individually selected by the Applicant. No single figure encompasses all of these examples that Applicant wishes to elect in order to conform to the requirement and to avoid further delay in the prosecution of this patent application. In other words, the requirement is impossible to conform to when considered in combination with the figures of the patent application and established species election practice, not even referencing the subject matter claimed. It is for this reason, the impossibility of complying with the requirement, that the MPEP instructs examiners to require applicants to elect a figure as a species and to identify the claims that correspond to that species so that examination on the merits of the patent application can begin with respect to the identified claims. This impossibility demonstrates the illegality of the requirement.

As explained in the telephone conversations of May 8, 2003, the Examiner is of the view of the Applicant will subsequently present amended claims directed to disparate elements within each of the four categories taken from different figures. Of course, the traditional species election requirement and response would prevent such an occurrence, absent the allowance of a generic claim. The Examiner's concern is, at best, speculative and hypothetical, and has generated confusion rather than providing some unquantifiable benefit to the Applicant.

For each of the foregoing reasons, Applicant reiterates his request that either the Official Action of February 26 and the Communication of May 5, 2003 be withdrawn and a fresh start be made in the examination of the claims of this patent application or examination begin on the merits of the claims identified below and the species election requirement be made final so that its propriety can be determined upon petition.

In an attempt to reply and to identify examples of heat sinks, fan mounting arrangements, attachment clip arrangements, and assembly means.¹

According to analysis by the undersigned, with regard to heat sink structures, i.e., not designs, disclosed, there are at least three heat sink structure examples, the first exemplified in Figures 1, 2, and 16, the second example illustrated in Figures 3, 4, 9, and 17, and the third example illustrated in Figures 5-7 and 10-13. If an election has to be made, Applicant elects the examples of Figure 5-7 and 10-13 upon which at least claims 1, 5, and 23 are readable.

With regard to the fan mount examples, the only examples illustrated appear in Figures 2, 4, and 7. If an election must be made, Applicant elects the example of Figure 4 to which dependent claims 9-14 pertain.

With regard to a clip attachment arrangement, Applicant does not understand the Examiner's term. For example, claim 1 alludes to an environmental element of a clip but does not affirmatively claim a clip as part of the claimed subject matter. In fact, no pending claim claims a clip. An embodiment of a clip is illustrated in Figures 12 and 13 of the patent application and the embodiments of Figures 1-5, 7, 9-13, 16, and 17 all provide for a centrally located clip used in mounting the heat sink. If an election is required, Applicant elects the examples of Figures 1-5, 7, 10-13, 16, and 17. Claims 1-14 and 16 pertain to this clip attachment arrangement.

As earlier noted, the only depicted element corresponding to the examples the Examiner provides as to assembly means are rivets visible in Figures 1, 3-5, 7, 10-13, and 16. Applicant clearly elects the rivet as an example of the claimed assembly means, referred to in the claims as "means for binding", not an assembly means. Claims 1-23 read on this elected example.

How the election of these examples is to be employed in the examination of the application, i.e., which claims are to be examined, is not apparent from these four claim listings. Perhaps all of claims 1-23 should be examined since they all pertain to the example of the means for binding selected. Perhaps claims 1-14 and 16 should be examined because all pertain to a heat sink permitting clip mounting the heat sink. In the response filed March 24, 2003, Applicant requested the examination of claims 1 and 5. Upon further review, it is apparent that with regard to Figure 5, which was the species elected in that response, not only

¹ The examples of assembly means identified by the Examiner are rivets, shown in numerous figures, screw fasteners and brazing. Neither of the latter two examples are shown anywhere in any figure. Apparently screw fasteners means nuts and bolts that are referred to at page 9 of the patent application as is brazing. If species represent embodiments, it is unclear how elements that are not depicted anywhere in the patent application can be considered part of a species.

If still a further election is required in
t elects claims 1, 5, and 23 for
to the MPEP, might be considered

ted,

Jeffrey A. Wyand, Reg. No. 29,458

LEYDIG, VOIT & MAYER

700 Thirteenth Street, N.W., Suite 300

Washington, DC 20005-3960

(202) 737-6770 (telephone)

(202) 737-6776 (facsimile)

Date: May 21, 2003
JAW:ves